

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sung-hee HWANG et al.

Serial No. 10/751,729

Group Art Unit: 2627

Confirmation No. 1518

Filed: January 6, 2004

Examiner: Thomas D. Alunkal

For: DISC WITH TEMPORARY DEFECT MANAGEMENT AREA, AND DISC DEFECT
MANAGEMENT METHOD AND APPARATUS THEREFOR

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed December 28, 2006, having a shortened period for response set to expire on January 29, 2007 (January 28 being a Sunday). The following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Species I of FIG. 10. It is respectfully submitted that claims 1-17 and 19-26 are generic to or included in Species I.

Moreover, the Examiner asserts on page 2 of the Office Action that only claims 1 and 19 are considered generic to Species I through IV. However, it is respectfully submitted that claim 10 is similarly generic to the Species I through IV, especially as claim 18 of a non-elected species depends from claim 10. It is also respectfully submitted that claim 22 is similarly generic to the Species I through IV, especially as claim 27 of a non-elected species depends from claim 22. As such, it is respectfully requested that at least claims 1, 10, 19, and 22 are generic for the claims in Species I through IV.

II. Applicants Traverse the Requirement

On page 2 of the Office Action, the Examiner asserts that applicants must elect between species drawn to Fig. 10 (Species I), to FIG. 11 (Species II), FIG. 15 (Species III), and FIG. 16

(Species IV). As noted in MPEP 806.04, "if [an] application contains claims directed to more than a *reasonable number of species*, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application." (italics added). As such, applicants are allowed to have a reasonable number of species included in a single application without restriction. Moreover and consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species. Such a finding and evidence supporting the finding is required in order prevent piecemeal examination and for meaningful review to be provided under the Administrative Procedures Act, 5 U.S.C. §706. In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001).

The Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species I through IV. Specifically, the Examiner has not provided evidence that the existence of four species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species I through IV.

It is further respectfully believed that any search of the technologies related to the Species I would also adequately cover the search needed for Species II through IV. By way of example, FIG. 11 is an example of the concept set forth more broadly in FIG. 10 such that a search of Species II would naturally encompass a search of Species I, and vice versa. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species I through IV which is out of proportion with the delay and expense visited on the applicants in protecting the invention recited in Species II through IV, and has not otherwise shown the number of species to be unreasonable. As such, it is respectfully requested that the Examiner reconsider and withdraw the election.

III. Conclusion

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Serial No. 10/751,729

Docket No. 1793.1154

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI LLP

By: 
James G. McEwen
Registration No. 41,983

1400 Eye Street, NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510

Date: Jan. 26, 2007